

REMARKS

Upon entry of the present amendment, claims 1-5 will remain pending in the above-identified application and stand ready for further action on the merits. Claims 1-3 have been amended. The amendments made herein to the claims do not introduce new matter into the application as originally filed.

Claims 1-3 have been amended so that the amount of zeolite contained in the base particles is 10 wt.% or less. The amendments to claims 1-3 find support in the application as originally filed at page 10, lines 17-18.

Claim Rejections 35 USC §102(b)

Claims 1-5 have been rejected under the provisions of 35 USC § 102(b) as being anticipated by Kubota et al. EP 0 969 082 (EP '082).

Claim 2 has been rejected under the provisions of 35 USC § 102(b) as being anticipated by Kanai et al. US 5,821,207 (US '207).

Reconsideration and withdraw of each of the above rejections is respectfully requested based on the following remarks and considerations.

Legal Standard for Determining Anticipation

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "When a claim covers several structures or compositions, either generically or as alternatives, the claim

is deemed anticipated if any of the structures or compositions within the scope of the claim is known in the prior art." *Brown v. 3M*, 265 F.3d 1349, 1351, 60 USPQ2d 1375, 1376 (Fed. Cir. 2001) "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim, but this is not an *ipsisimilis* test, i.e., identity of terminology is not required. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

Novelty Over the Cited Art

In the official action, it was stated that the subject matter of claims 1-5 is not novel *vis-à-vis* EP '082 and that the subject matter of claim 5 is not novel *vis-à-vis* US '207. The Examiner is kindly requested to reconsider these objections for the following reasons.

According to the claims now on file, the amount of zeolite contained in the base particles of the present invention is 10 wt.% or less. However, EP '082 discloses detergent particles containing base particles that contain a zeolite in an amount of 50 wt.% (see Example 4 in connection with Table 1). The base particles of claim 2 of the present application therefore differ from the base particles of EP '082 and are thus novel *vis-à-vis* EP '082. For the same reason, the detergent particles of claim 1, the process of claim 3 and the detergent composition of claim 5 are novel *vis-à-vis* EP '082 as well.

The detergent composition of US '207 differs from the detergent composition of claim 5 of the present invention in that it does not comprise detergent particles comprising base particles which are obtained by a spray-drying method and which have an average particle size of from

150 to 400 μm . Therefore, the detergent composition of US '207 does not take away from or otherwise negatively affect the novelty of the detergent composition of claim 5 of the present application.

Incidentally, at page 2 of the outstanding office action, the Examiner refers to "palmitic acid (an acid precursor of anionic surfactant)". In the present invention, however, a liquid acid precursor of a non-soap anionic surfactant is used, and as such, palmitic acid is not a substance meeting the claimed limitations of the instant application. For this reason, the Examiner's comments concerning this point must be reconsidered at present.

Legal Standard for Determining Prima Facie Obviousness

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Week*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

"There are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art." *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998)

(The combination of the references taught every element of the claimed invention, however without a motivation to combine, a rejection based on a *prima facie* case of obvious was held improper.). The level of skill in the art cannot be relied upon to provide the suggestion to combine references. *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999).

"In determining the propriety of the Patent Office case for obviousness in the first instance, it is necessary to ascertain whether or not the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the reference before him to make the proposed substitution, combination, or other modification." *In re Linter*, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. "The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." *In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). See also *In re Lee*, 277 F.3d 1338, 1342-44, 61 USPQ2d 1430, 1433-34 (Fed. Cir. 2002) (discussing the importance of relying on objective evidence and making specific factual findings with respect to the motivation to combine references); *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

The Supreme Court of the United States has recently held that the teaching, suggestion, motivation test is a valid test for obviousness, but one which cannot be too rigidly applied. See *KSR Int'l Co. v. Teleflex Inc.*, No. 04-1350, slip op. at 11 (U.S. April 30, 2007).

The Supreme Court in *KSR Int'l Co. v. Teleflex, Inc.*, No. 04-1350 (U.S. April 30, 2007) reaffirmed the Graham factors in the determination of obviousness under 35 U.S.C. § 103(a). The four factual inquiries under Graham are:

- (a) determining the scope and contents of the prior art;
- (b) ascertaining the differences between the prior art and the claims in issue;
- (c) resolving the level of ordinary skill in the pertinent art; and
- (d) evaluating evidence of secondary consideration.

Graham v. John Deere, 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966).

The Court in *KSR Int'l Co. v. Teleflex, Inc.*, *supra*, did not totally reject the use of "teaching, suggestion, or motivation" as a factor in the obviousness analysis. Rather, the Court recognized that a showing of "teaching, suggestion, or motivation" to combine the prior art to meet the claimed subject matter could provide a helpful insight in determining whether the claimed subject matter is obvious under 35 U.S.C. § 103(a).

Even so, the Court in *KSR Int'l Co. v. Teleflex, Inc.*, *ibid.*, rejected a rigid application of the "teaching, suggestion, or motivation" (TSM) test, which required a showing of some teaching, suggestion, or motivation in the prior art that would lead one of ordinary skill in the art to combine the prior art elements in the manner claimed in the application or patent before holding the claimed subject matter to be obvious.

Non-Obviousness Over the Cited Art

Example 4 of EP '082 is considered as the closest prior art Example, because it discloses a detergent composition comprising base particles that are dry-neutralized with a liquid acid precursor of an anionic surfactant.

The detergent composition of the present invention differs from the detergent composition of EP '082 in that the base particles may contain a zeolite in an amount of 10 wt.% or less, while the base particles used in the detergent composition of EP '082 contain 50 wt.% of a zeolite.

However, when the zeolite is formulated in a large amount, there is the possibility that the zeolite decomposes during the dry-neutralization reaction (e.g., *see page 10, lines 15-17 of the instant specification*).

In EP'082, there is no indication as to the risk of decomposition of the zeolite during the dry neutralization step if the amount of zeolite used becomes too high. The question regarding inventive step (and thus the non-obviousness of the instant invention) is not whether the skilled person could have used a smaller amount of zeolite in the base particles of EP '082, but whether they would have done so in order to avoid decomposition. However, as there is not even an indication in EP '082 as to the potential risk of decomposition of the zeolite, the skilled person was not motivated whatsoever to use a smaller amount of zeolite in the base particles of EP '082.

Furthermore, US '207 does not even disclose or suggest base particles that were obtained by spray-drying and that contain a solid alkali inorganic substance (A) and a zeolite. Therefore, the skilled person did not get any hint from US '207 as to the amount of zeolite in base particles.

Therefore, the detergent composition of the present invention is not derivable in an obvious way from a combination of EP '082 with US '207.

Consequently, the detergent particles of claim 1, the base particles of claim 2, the process of claim 3 and the detergent composition of claim 5 involve an inventive step and are completely non-obvious over the cited art references of record. Any contentions of the USPTO to the contrary are respectfully requested to be reconsidered at present.

CONCLUSION

Based upon the amendments and remarks presented herein, the Examiner is respectfully requested to issue a Notice of Allowance clearly indicating that each of pending claims 1-5 are allowed and patentable under the provisions of Title 35 of the United States Code.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact John W. Bailey (Reg. No. 32,881) at the telephone number below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.14; particularly, extension of time fees.

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Respectfully submitted,



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